

REMARKS

I. Anticipation Rejection

Claims 1 to 4 and 6 to 12 were rejected under 35 U.S.C. 102 (e) as anticipated by Bolton, US 2004/0161282 A1 (referred to as US '282).

A. Amended Claim 1

Claim 1 has been amended to claim an applicator for an oxidative hair dyeing mixture, which is formed by mixing the oxidative hair dye composition and the oxidizing agent when they are dispensed through the product-dispensing openings 5, 6 into the product-dispensing area or spot 4. Basis for this wording is provided on pages 3 and 4 of the specification, especially lines 17 to 19 of page 3 and lines 4 to 8 of page 4.

Claim 1 has been amended to claim the applicator containing the oxidative hair dye composition (in a first compartment) and containing an oxidizing agent (in a second compartment). In other words, claim 1 now claims the combination of the oxidative hair dye composition, the oxidizing agent and the applicator. New dependent claim 16 limits the oxidizing agent to peroxide solution (basis in applicant's specification on page 3, line 21, and last paragraph on page 7).

US '282 does disclose an embodiment of a marker that contains one coloring medium in one compartment and another coloring medium in another compartment, which chemically react to cause a color change [0024, 0071, 0073]. However US '282 does not disclose or suggest that the respective coloring medium contained in the applicator or marker is an oxidative hair dye composition or an oxidizing agent.

In operation, an oxidative hair dyeing mixture results when the oxidative hair dye composition is dispensed from the applicator together with the oxidizing agent. The oxidative hair dyeing mixture and the oxidative hair dye composition must contain special compounds, usually a combination of a developer and coupler, which react with the oxidizing agent to form a colored dye species that adheres to and remains fast on the hair for an extended period of time, in spite of bleaching by the sun and repeated washing with shampoo.

US '282 does not disclose any oxidative hair dye composition contained, e.g. according to claim 2 of US '282, in either compartment of the applicator. A coloring medium is not the same as an oxidative hair dye composition (because the coloring medium does not necessarily need to react with an oxidizing agent and would not necessarily adhere to the hair). An indicator as described in paragraph [0073] and also [0024] and [0071] of US '282 does react to change color, but reacts with an acid or base to change color, not with an oxidizing agent. Thus the indicator mentioned in US '282 is not an oxidative hair dye composition.

In addition, the eradicating material of US '282 is not limited to an

oxidizing agent. The eradicating material could be a solvent that merely dilutes or washes away the ink. Furthermore with respect to dependent claim 16 the eradicating material is not limited to a peroxide solution.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

Amended claim 1 now claims a combination of the applicator, an oxidizing agent in one compartment and an oxidative hair dye composition in another compartment. US '282 does not disclose or suggest the applicator containing the oxidizing agent in one compartment and the oxidative hair dye composition in the other compartment.

The applicator as claimed in amended claim 1 has special advantages for dyeing of hair, because it allows one to dye individual locks or strands of hair in special patterns, such as point-like or spot-like patterns (see page 8 of applicant's specification). This sort of dyeing is not possible with the conventional kits for oxidative dyeing of human hair.

For the foregoing reasons and because of the changes in amended claim 1, withdrawal of the rejection of claims 1 to 4 and 6 to 12 as anticipated under 35 U.S.C. 102 (e) by Bolton, US 2004/0161282 A1 (referred to as US '282) is respectfully requested.

Also it is respectfully submitted that new claim 16, limited to peroxide

solution, is neither disclosed nor suggested by Bolton and should not be rejected under 35 U.S.C. 102 (e) as anticipated by Bolton or under 35 U.S.C. 103 (a) as obvious over Bolton.

B. New Claims 17 to 20

It is respectfully submitted that new claim 17 should not be rejected under 35 U.S.C. 102 (e) as anticipated by Bolton.

New claim 17 contains a special combination of features from the originally filed claims and is drafted to claim the special embodiment of applicant's figure 3, which has the special advantage that the inner compartment is exchangeable. Thus the color of the dyeing mixture can be changed easily and quickly during a single dyeing treatment merely by exchanging the inner compartments. However claim 17 does not claim a combination of an applicator, an oxidative hair dye composition and an oxidizing agent contained in the applicator.

New claim 17 includes a combination of the features of claims 1, 2, 6, 10, 11 and 12. This special combination of features facilitates an easy and rapid exchange of dye composition during operation to change colors of parts of the dyed hair.

In contrast, the specification of US '282 does not disclose or suggest that the tubular housing 18 with the transorb 21 and nib is exchangeable or replaceable in the marker of US '282 (Fig. 13). If this feature can be found

anywhere in the disclosure of US '282 in connection with fig. 13, its location should be cited by paragraph and page.

The description of the embodiment of fig. 13 in paragraph [0063] of US '282 does not disclose or suggest a second insertable or exchangeable annular compartment, according to page 2 of the Office Action. The paragraph [0063] only states that the inner nib 25 has an insertable cartridge 47. There is no statement that the wall or housing 18, or the transorb included within it, is or are exchangeable or insertable. The description regarding the exchangeable housing 18 in paragraph [0061] above paragraph [0063] relates to a different embodiment, which features that are not in common with the embodiment shown in fig. 13.

Different features that are not in common in the different embodiments shown in the different figures of US '282 are not interchangeable for the purposes of an anticipation rejection under 35 U.S.C. 102. For example, the embodiment of figures 7 to 9 [0061] does include a housing 18 with an inner nib 25 which can be withdrawn from the applicator according to paragraph [0061]. However an anticipation rejection cannot be based on the embodiment shown in figures 7 to 9 because the nib tip 25 shown in fig. 7 is not a felt or spongy material. The nib tip 25 is shown in figure 7 as a thin tube of impermeable material having a single capillary passageway (see paragraphs 0015, 0049). The nib tips shown in the figures with a hollow or blank section have the single narrow passageway passing to the tip 27 and are not made of felt or spongy material. In contrast, new claim 17 requires that the inserts 7, 8 are arranged in the product-

dispensing openings 5,6 and are made of spongy material, bristles or fabric. Thus the embodiment of figures 7 to 9 cannot anticipate the applicator claimed in new claim 17.

Both inserts comprising spongy material, bristles or fabric of US '282 are not arranged in the product-dispensing openings 5,6 in the case of the embodiments shown in the figures of US '282. In the case of one of the inserts a nib 25 extends from the corresponding insert in the interior of the applicator to the respective opening.

No embodiments disclosed in the specification of US '282 contain the combination of features claimed in the new claim 17.

For the foregoing reasons and because of the special combination of features in the new claim 17, it is respectfully submitted that none of the new claims 17 to 20 should be rejected under 35 U.S.C. 102 (e) as anticipated by Bolton.

II. Obviousness Rejections

Claim 5 was rejected as obvious under 35 U.S.C. 103 (a) over Bolton.

Claims 13 to 15 were rejected as obvious under 35 U.S.C. 103 (a) over Bolton, in view of Hashimoto.

These claims claim preferred embodiments. Their features are not currently relied on to establish patentability of applicant's claimed invention.

Hashimoto discloses a cap-less writing instrument that uses a foil to cover

dispensing openings. However Hashimoto does not disclose any of the distinguishing features of amended claim 1 or claim 17.

Hashimoto does not disclose an instrument with two openings next to each other with felt or fabric inserts in the openings at the tip of the instrument. Thus Hashimoto does not supply a hint or suggestion of the features that are not disclosed in Bolton in claim 17.

Hashimoto does not disclose an instrument that contains two compartments with a hair dye composition in one compartment and an oxidizing agent in the other compartment. Thus Hashimoto does not suggest the features of amended claim 1.

Because of the distinguishing features in amended claim 1, withdrawal of the rejection of claim 5 under 35 U.S.C. 103 (a) over Bolton is respectfully requested and withdrawal of the rejection of claims 13 to 15 under 35 U.S.C. 103 (a) over Bolton, in view of Hashimoto, is respectfully requested.

Furthermore because of the distinguishing features in amended claim 1 and new claims 16 to 20, it is respectfully submitted that new claims 16 to 20 should not be rejected as obvious under 35 U.S.C. 103 (a) over Bolton alone or Bolton in view of Hashimoto.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the

case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, reading "Michael J. Striker". The signature is written in a cursive, flowing style with a large, prominent "M" and "S".

Michael J. Striker,

Attorney for the Applicants

Reg. No. 27,233